



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,144	08/30/2001	Bertram Eichel	20453/2	8651

7590 04/03/2003

Mark S. Leonardo
Brown Rudnick Freed & Gesmer
One Financial Center
Box IP, 18th Floor
Boston, MA 02111

EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 04/03/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/943,144	EICHEL, BERTRAM
	Examiner Dionne A. Walls	Art Unit 1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-42 is/are pending in the application.

4a) Of the above claim(s) 26-42 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 December 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-25, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there will not be a serious burden on the Examiner if restriction is not required since the field of search of all claims would "substantially overlap" and because the claims are so closely related that the fields of search would "necessarily be co-extensive". This is not found persuasive because, as stated in the Restriction Requirement, the claims embody five distinct inventions – each relating to distinct areas – which are either separately usable, or disclosed as being unrelated or having different modes of operation, function or effects. The Examiner has stated the reasons upon which she has based her conclusions. These reasons, coupled with the fact that the inventions have acquired separate status in the art due to their different classifications and/or divergent subject matter and, additionally, because the search required for one invention group is not required for the others, is the justification for requiring the restriction.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2,5,7,9,15,17-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Schreus et al (US. Pat. No. 2,815,760).

Schreus et al discloses all that is recited in the claims (see cols. 1-4 and 7)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 6, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreus et al (US. Pat. No. 2,815,760) in view of Eichel (US. Pat. No. 3,459,194).

Regarding the claims, while Schreus et al may not disclose using a strongly basic anion exchange resin that is in bicarbonate form; or a filter that further comprises methyl cellulose or moisture; or a filter having a ratio of filter material to tobacco material in the range of from 1:2 to 1:10, Eichel discloses a tobacco product incorporating a filter, containing ion exchange resin, designed to inhibit the adverse effects of tobacco smoke, said filter including the above-claimed components (see col. 2, lines 47-50, col. 4, lines 2-24; and col. 11, line 73). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate these components into the filter of Schreus et al since both filter are aimed at reducing the health-affecting volatile substances contained in tobacco smoke by using ion exchange materials.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schreus (US. Pat. No. 2,815,760) in view of Bavley et al (US. Pat. No. 3,280,823).

While Schreus may not specifically state that the strongly acidic cation exchange resin is selected from the group consisting of Dowex 50 and Dowex 50-W, Bavley et al discloses a filter employing strong cation-type resins, and discloses that Dowex 50-W is a known resin of such type and is suitable for use as an ion-exchange in its filter (see col. 3-4). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate Dowex 50, to be used as a strongly acidic cation exchange resin in the filter of Schreus, since such resin is known and used for the purpose of filtering harmful tobacco smoke constituents – as evidenced by the disclosure of Bavley et al.

7. Claims 1-2,5,7, 9-15, 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreus et al (US. Pat. No. 2,815,760).

While Schreus et al may not specifically recite the claimed threading arrangement of the filter cartridge, it does state that the filter cartridge is designed so that it fits tightly into a hollow chamber of a holder, pipe, etc. (see col. 5, lines 25-26). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide male-threading for use with female channel threading to secure the cartridge, tightly, into a channel of a pipe or holder since threaded arrangements are conventional in many arts and would merely serve to ensure that the cartridge remains immobile during use, but is easily replaced when necessary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-

0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.


Dionne A. Walls
April 1, 2003